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In re Application of  
Kikinis  
Application No. 09/782,916  
Filed: February 13, 2001  
Attorney Docket No. 004688.P019/ 091451.00131  
For: A METHOD AND SYSTEM FOR  
LOCALIZED ADVERTISING USING  
LOCALIZED 3-D TEMPLATES

## OFFICE OF PETITIONS

### ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed November 8, 2005, to revive the above-identified application.

The petition under 37 CFR 1.137(a) is **dismissed**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 CFR 1.137." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

This application became abandoned for failure to timely respond to the final Office action mailed March 25, 2004 which set an extendable three month period for reply. Accordingly, this application became abandoned on June 26, 2004. A Notice of Abandonment was mailed on September 8, 2005.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by (1) the required reply, unless previously filed.; (2) the petition fee as set forth in § 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section. This petition does not satisfy requirement (3).

Regarding (3) above, petitioner has not shown to the satisfaction of the Commissioner that the entire delay from the due date of the reply to the filing of a grantable petition was unavoidable.

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable". 35 U.S.C. §133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word unavoidable ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

Petitioner alleges that the March 25, 2004 final Office action was mailed to petitioner's prior attorneys, despite the fact that a Revocation of Power of Attorney and Appointment of New Power of Attorney was filed on January 2, 2004 (certificate of mailing date December 29, 2003). The January 2, 2004 (certificate of mailing date December 29, 2003) document is present in the application file.

However, the revocation/power of attorney is not acceptable because the statement under 37 CFR 3.73(b) is not present in the application file, although the box indicating it was submitted on January 2, 2004 (certificate of mailing date December 29, 2003) was checked. As stated in MPEP 324, "The establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted. 37 CFR 3.73(c). If the submission establishing ownership is not present, the action sought to be taken will not be given effect."

The assignee's ownership may be established under 37 CFR 3.73(b) by submitting to the Office in the Office file related to the matter in which action is sought to be taken:

- (A) documentary evidence of a chain of title from the original owner to the assignee (e.g. copy of an executed assignment submitted for recording); or
- (B) a statement specifying, by reel and frame number, where such evidence is recorded in the Office.

The assignee did not establish ownership. Therefore, the January 2, 2004 (certificate of mailing December 29, 2003) revocation/power of attorney was not entered. The final Office action was properly mailed to the correspondence address of record and the attorneys of record failed to respond in a timely manner.

Delay in prosecution resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not unavoidable. See, Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

Therefore, the petition under 37 CFR 1.137(a) is dismissed.

The August 3, 2005 acceptance of the revocation/power of attorney resubmitted on July 1, 2005 was improper for the same reason that the original revocation/power of attorney could not be accepted. The assignee still has not established ownership. **The assignee should submit a statement under 37 CFR 3.73(b) as soon as possible.** A courtesy copy of this decision will be mailed to the address listed on the petition.

Regarding fees, pursuant to 37 CFR 1.136, an extension of time must be filed prior to the expiration of the maximum period obtainable for reply to avoid abandonment. Accordingly, since the \$1,020.00 extension of time submitted with the petition on November 8, 2005 was subsequent to the maximum period obtainable for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

Petitioner is encouraged to file a petition to revive under the unintentional standard of 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

**By mail:**

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Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

**By hand:** U.S. Patent and Trademark Office  
Customer Service Window, Mail Stop Petition  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

**By FAX:** (571) 273-8300 - ATTN: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3230.



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